

REMARKS

This paper is responsive to the Office Action dated February 2, 2007. All rejections and objections of the Examiner are respectfully traversed. Reconsideration and further examination are respectfully requested.

At paragraphs 2-5 of the Office Action, the Examiner objected to the drawings as originally filed. Amendments to the Specification and Fig. 23 herein are respectfully believed to meet all requirements of the Examiner in this regard.

At paragraph 6 of the Office Action, the Examiner rejected claim 29 as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

Applicants first respectfully note that the PTO has for years accepted claims directed to program code embodied in a carrier wave. This type of claim format is the direct outcome of published training materials used in the PTO that expressly included an example of an acceptable claim to a "computer data signal embodied in a carrier wave". In fact, the PTO has issued many patents having at least one such "propagated signal" claim ("hundreds" of such patents have been issued, according to "RESPONSE TO THE PTO REQUEST FOR COMMENTS ON PROPOSED GUIDELINES RE:SUBJECT MATTER ELIGIBILITY", submitted to the PTO by The National Association of Patent Practitioners, July 31, 2006). In reliance on these well known facts, Applicants have in this case applied for claim 29 to protect the invention in what has become a standard claim format used for computer related inventions. Applicants respectfully submit that for the Patent Office to now to promote rejection of such claims, based on interpretation of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility published on 22 November 2005 ("Interim Guidelines"), is an unfair reversal of a well established policy, based solely on administrative actions internal to the Patent

Office, without sufficient motivation or support in statutory or case law. No new case has been decided, or law enacted, that provides a reasonable basis for such a change in treatment of this type of claim.

Applicants respectfully assert that 35 U.S.C. 101 still does not preclude signal-related claims such as the present claim 29. 35 U.S.C. 101 states as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The present claim 29 should at least be considered proper subject matter as a "manufacture" under 35 U.S.C. 101. Applicants respectfully disagree with the proposition espoused in the Interim Guidelines that signal claims lack physical substance. The present claim 29 is directed to "A computer data signal embodied in a carrier wave . . . ", and as such would be recognized by those skilled in the art as a *physical* signal, recognizable by a computer system, and used to convey computer program code and/or data through a computer communication network by way of a carrier wave on which it is embodied. Applicants respectfully submit that the subject matter of claim 29 is thus physically substantial, and claim 29 is therefore clearly not directed to something that would be considered physically insubstantial, such as a mere mental process or thought. As is well known in the art, the relevant physical substance of the "computer data signal" in claim 29 is the representation of the computer program it embodies, which in turn is significant to the functional operation of a receiving computer system.

In addition, the category of "manufacture" in 35 U.S.C. 101 includes no requirement that a claim be directed to a "tangible physical article or object", as asserted in the Interim Guidelines. Such a requirement would run contrary to the Supreme Court's well known holding in *Diamond V. Chakrabarty* that the statute is intended to include "anything under the sun that is made by

man". Similarly, the Federal Circuit has held that "physical matter" is not an appropriate test for the determination of patentable subject matter. For example, *In re Lowry* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) found eligible subject matter for an invention in which ". . . the stored data adopt no physical 'structure' per se. Rather, the stored data exist as a collection of bits . . ."

For these reasons Applicants respectfully urge that claim 29 as it currently stands is directed to statutory subject matter under 35 U.S.C. 101.

At paragraphs 7-8 of the Office Action, the Examiner rejected claims 1-6, 10-15, 19-25, 28 and 29 for obviousness under 35 U.S.C. 103, citing United States patent number 5,793,365 of Tang et al. Applicants respectfully traverse this rejection.

Tang et al. disclose a system for providing each networked computer user with a user interface displaying visual representations of workers in the user's workgroup, and communication mechanisms for efficiently and easily contacting any of the displayed workers. The visual representations of other users in Tang et al. indicate the activity level of the other users, to help predict if the other users are likely to be available for an interaction.

More specifically, a gallery window disclosed in Tang et al. includes visual representations of a current worker's work group, and a worker may be required to decide or select which other workers' visual representations are displayed in the gallery window. As shown in Fig. 3 of Tang et al., if the gallery is used to initiate a desktop video-conference, a separate display window is provided referred to as a glance window. The glance window of Tang et al. provides panels of video stream data for each of the participants of the video-conference, and includes an object portal that allows the participants to pass data by cut and paste (or drag and drop) operations. If a worker is already engaged in a desktop video teleconference when the

current worker attempts to communicate with that worker, the glance window of Tang et al. displays the names of the participants and/or provides their images to the current worker. This allows the current worker to use the Tang et al. system to determine if it is appropriate to attempt to join in the ongoing interaction.

Nowhere in Tang et al. is there disclosed or suggested any method or system for providing a local user with the identities of users with whom a remote user has been communicating, including:

obtaining a plurality of user representations, *each of said plurality of user representations corresponding to a respective one of a plurality of users with whom said selected remote user recently communicated across a plurality of different communication applications*; and

presenting said plurality of user representations in a computer system display, wherein all of said plurality of user representations are presented simultaneously in said computer system display, and wherein said plurality of user representations are presented in an order corresponding to an order in which said remote user communicated with each of said users. (emphasis added)

as in the present independent claim 1. Independent claims 10, 19, 28 and 29 include analogous features. While Tang et al. disclose a system in which a local user is shown representations of participants in a single, current desktop video conference being held with a remote user (within the glance window), there is no way for a user of Tang et al. to view representations of users with whom a remote user has recently communicated across a plurality of different communication applications, as in the present independent claims. Accordingly, the information displayed regarding *a single current communication session in a single communication application* provided by Tang et al. is far different from the simultaneous presentation of the representations of users with whom a remote user has recently communicated across *a plurality of different*

communication applications, as in the present invention as set forth in independent claims 1, 10, 19, 28 and 29.

For the above reasons, Applicants respectfully submit that Tang et al. does not disclose or suggest all the features of the present independent claims 1, 10, 19, 28 and 29. Accordingly, Tang et al. does not form the basis for a *prima facie* case of obviousness under 35 U.S.C. 103 with regard to independent claims 1, 10, 19, 28 and 29. As to dependent claims 2-6, 11-15, and 20-25, they each depend from claims 1, 10, and 19, and are respectfully believed to be patentable over Tang et al. for at least the same reasons.

In paragraph 9 of the Office Action, the Examiner rejected claims 7-9, 16-18 and 25-27 for obviousness under 35 U.S.C. 103, citing the combination of Tang et al. with United States patent number 6,697,840 of Godefroid et al. ("Godefroid et al."). Applicants respectfully traverse this rejection.

Godefroid et al. disclose presence awareness initiatives implemented in a collaborative system that enables a user to set presence awareness policies, and that provides a reasonably high assurance that the system will correctly implement those policies. The collaborative presence awareness system of Godefroid et al. enables users to specify presence awareness policies, and includes tools to establish a level of assurance that the presence awareness system has the capability to implement correctly, substantially all possible presence awareness policies. The presence awareness policy specifications of Godefroid et al. are modular relative to the rest of the presence awareness system, and can be modified without having to modify computational modules or user interface program code of the presence awareness system. A user of the Godefroid et al. system can update his or her presence information. In accordance with still another aspect of the invention, the Godefroid et al. system automatically collects presence

information about the user and automatically updates his or her presence information. The presence awareness system of Godefroid et al. may use specification-based testing at run-time to monitor whether some users' presence awareness policies have inadvertently been violated, further strengthening the reliability of the system.

In the Godefroid et al. system, a user may inquire about the presence of other users. These inquiries may relate to a user's interest in the login status of another user, the screen saver status of another user, whether another user is in a collaborative session, the other user's indicated willingness to interact (a "door" status), access rules and settings of the other user, and the other user's calendar, location, phone number, email address, and real name (in the case of anonymous participation).

The relevant teachings of Tang et al. are summarized above.

Nowhere in the combination of Tang et al. and Godefroid et al. is there disclosed or suggested any method or system for providing a local user with the identities of users with whom a remote user has been communicating, including:

obtaining a plurality of user representations, *each of said plurality of user representations corresponding to a respective one of a plurality of users with whom said selected remote user recently communicated across a plurality of different communication applications*; and

presenting said plurality of user representations in a computer system display, wherein all of said plurality of user representations are presented simultaneously in said computer system display, and wherein said plurality of user representations are presented in an order corresponding to an order in which said remote user communicated with each of said users. (emphasis added)

as in the present independent claim 1. Independent claims 10 and 19 include analogous features. Similarly as in Tang et al., there is no way for a user of Godefroid et al. to view representations of users with whom a remote user has recently communicated across a plurality of different

communication applications, as set forth in the present independent claims. Accordingly, the combination of Tang et al. with Godefroid et al. would still provide only information regarding *a single current communication session in a single communication application*, and accordingly is also far different from the simultaneous presentation of the representations of users with whom a remote user has recently communicated across *a plurality of different communication applications*, as in the present invention as set forth in independent claims 1, 10, and 19.

For the above reasons, Applicants respectfully submit that the combination of Tang et al. and Godefroid et al. does not disclose or suggest all the features of the present independent claims 1, 10 and 19. Accordingly, the combination of Tang et al. and Godefroid et al. does not support a *prima facie* case of obviousness under 35 U.S.C. 103 with regard to independent claims 1, 10 and 19. As claims 7-9, 16-18, and 25-27 each depend from claims 1, 10 and 19, they are respectfully believed to be patentable over the combination of Tang et al. and Godefroid et al. for at least the same reasons.

Reconsideration of all claims is respectfully requested.

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Applicants' Attorney at the number listed below so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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Date

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